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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,493	04/24/2000	John E. Tafoya	MCS-019-99	7631

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EXAMINER

ALAM, UZMA

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 02/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/557,493

Applicant(s)

TAFOYA ET AL.

Examiner

Uzma Alam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-5, and 8-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Huang et al. U.S. Patent No. 5,996,714.

As per claims 1, 23, and 29, Huang discloses a computer-readable medium having a computer-implemented process for providing automatically generated completion information from entries in a dynamic list via a user interface and a display device having rendered thereon dynamically changing results of a resolution list and a user interface for providing automatically generated completion information from entries in a dynamic list to a user, comprising using a computer to perform the following acts:

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a set of entries derived by dynamically tracking a data store (column 7, lines 25-35; column 11, lines 49-56);

an extract module analyzing and extracting contact information from items within data store to dynamically track entries (column 7, lines 36-45; column 7, lines 57-65);

adding the contact information to the dynamic list (column 7, lines 25-35; column 7, lines 57-65);

a suggest module capable of generating a set of results dynamically generated and dynamically generating suggested entries from the contact information and related to user entry data (column 6, lines 65-67; column 7, lines 45-56; column 8, lines 61-67); and

at least one dynamic output providing or a menu that displays the suggested entries in the dynamic list via the user interface in real time as the user enters the data (column 6, lines 65-67; column 7, lines 1-5 and lines 57-65; column 11, lines 49-56).

As per claims 2, 25, and 30 Huang discloses the computer-implemented process of claim 1, the display device of claim 23, and the user interface of claim 29 wherein the data store includes:

at least one of previously sent and received email (column 5, lines 64-67; column 6, lines 1-10; column 6, lines 41-52; column 7, lines 14-24; column 10, lines 27-30);

email addresses and contacts that exist within previous systems (column 5, line 64-67; column 6, lines 1-10; column 6, lines 52-64);

email stores located on at least one of local and public servers (column 5, lines 64-67; column 6, lines 1-24; column 6, lines 52-64);

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current and previous contact databases (column 6, lines 8-24; column 6, lines 52-64; column 7, lines 14-24); and

data embedded within other electronic application files (column 6, lines 8-24; column 6, lines 65-67; column 7, lines 1-5; column 7, lines 14-24; column 10, lines 1-9).

See also Figure 1e.

As per claims 3, 26, and 31 Huang discloses the computer-implemented process of claim 1, the display device of claim 23, and the user interface of claim 29 wherein providing automatically generated completion information or results comprises providing a most probable match from the list to a portion of the user entry data (column 7, lines 25-35).

As per claim 4, Huang discloses the computer-implemented process of claim 1 wherein dynamically tracking a data store comprises scanning electronic files of at least one of particular types and in specific locations to locate contact information within the files (column 7, lines 25-35).

As per claim 5, Huang discloses the computer-implemented process of claim 4 wherein electronic files are scanned as they enter the data store (column 7, lines 37-45).

As per claims 8 and 27, Huang discloses the computer-implemented process of claim 1, and the display device of claim 23 wherein analyzing and extracting contact information from items within data store comprises:

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locating at least one of email addresses and contact information in the items (column 10, lines 54-61);

copying the information to a temporary storage (column 10, lines 62-64);

formatting the information (column 10, lines 64-67); and

providing the information for possible inclusion in the list (column 10, lines 62-63; column 11, lines 18-22).

See also column 5, lines 52-63.

As per claim 9, Huang discloses the computer-implemented process of claim 1 wherein adding the contact information to the dynamic list comprises adding the contact information to the list if the information has a weight of at least one of equal and greater than contact information already in the list (column 7, lines 14-24; column 7, lines 57-65).

As per claim 10, Huang discloses the computer-implemented process of claim 9 wherein information is not added to the list if it is already stored in the list (column 10, lines 42-50).

As per claim 11, Huang discloses the computer-implemented process of claim 9 wherein information is not added to the list if it is already stored in an address book (column 11, lines 31-42).

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As per claim 12, Huang discloses the computer-implemented process of claim 9 wherein contact information already in the list is updated by matching contact information extracted from the data store (column 11, lines 31-42; column 12, lines 1-18).

As per claim 13, Huang discloses the computer-implemented process of claim 1 wherein new contact information is added to the list as new information enters the data store (column 7, lines 46-55).

As per claim 14, Huang discloses the computer-implemented process of claim 1 wherein entries are dynamically weighted on the number of times that the entries have been used, and how recently the entries have been used (column 6, lines 37-40; column 7, lines 14-25; column 9, lines 23-31).

As per claim 15, Huang discloses the computer-implemented process of claim 1 wherein the size of the list is constrained (column 6, lines 31-40).

As per claim 16, Huang discloses the computer-implemented process of claim 1 wherein the size of the list is variable (column 6, lines 31-40; column 10, lines 30-42).

As per claim 17, Huang discloses the computer-implemented process of claim 15 wherein entries are weighted and wherein entries having greater weights replace entries having equal or lower weights if the list is full (column 7, lines 57-65).

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As per claim 18, Huang discloses the computer-implemented process of claim 1 wherein new entries are automatically added to the list after those entries are first used (column 6, lines 41-51).

As per claim 19, Huang discloses the computer-implemented process of claim 1 wherein entries are automatically removed from the list if they are added to an address book (column 11, lines 57-68; column 12, lines 1-20).

As per claim 20, Huang discloses the computer-implemented process of claim 1 wherein a user interface provides the capability to browse the list (column 6, lines 25-30).

As per claim 21, Huang discloses the computer-implemented process of claim 1, wherein entries from the resolution are selectively added to an address book via a user interface (column 7, lines 57-65).

As per claims 22 and 28, Huang discloses the computer-implemented process of claim 1, and the display device of claim 23 further comprising automatically suggesting to a user that specific entries from the list be added to at least one of an address book and contact database via the user interface (column 6, lines 30-40; column 7, lines 25-32).



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As per claim 24, Huang discloses the display device of claim 23, further comprising at least one selectable interface option displayed on the client to enable selection of a result in the resolution list in real time (column 7, lines 57-65).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang et al. U.S. Patent No. 5,966,714.

As per claims 6 and 7, Huang discloses “The computer-implemented process of claim 4 wherein particular electronic files within the data store are scanned” (column 7, lines 37-45). Huang does not expressly disclose, “wherein particular electronic files within the data store are excluded from scanning or email received from at least one of specific email addresses and Internet domains are excluded from scanning.” At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine scanning particular files or locations of Huang with excluding files or locations. A person of ordinary skill in the art would have been motivated to do this so that certain files or locations are not connected to and time is not wasted.

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As per claim 32, Huang discloses "The user interface of claim 29, wherein the user receives a prompt" (column 6, lines 22-25). Huang does not expressly disclose, "wherein the menu is a pop-up menu that appears in close proximity to an area where the user enters the data". At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the prompting display of Huang with a pop up menu. A person of ordinary skill in the art would have been motivated to do this because a pop up menu is a type of prompt for the user.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dean et al. U.S. Patent No. 6,055,512 discloses a data store with personal information that can be downloaded and used against new information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uzma Alam whose telephone number is (703) 305-8420. The examiner can normally be reached on Monday - Friday 8:30 - 5.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703) 308 - 7562. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-9052 for regular communications and (703) 746-7238 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

ua

February 20, 2003

  
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